

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFERSON J. GAINES

Appeal No. 1999-0286
Application No. 08/777,413¹

ON BRIEF

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 4 to 6 and 9 to 19, which are all of the claims pending in this application.

¹ Application for patent filed December 30, 1996. According to the appellant, the application is a continuation of Application No. 08/321,243, filed October 11, 1994, now abandoned.

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We REVERSE.

BACKGROUND

The appellant's invention relates to a top platform and interchangeable guide lane assemblage for vibratory feeders. An understanding of the invention can be derived from a reading of exemplary claim 5, which appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hendricks	4,952,109	Aug.
28, 1990		
Lofstedt	5,116,185	May 26,
1992		
Holcomb et al. (Holcomb)	5,154,316	Oct.
13, 1992		
Wiese	5,361,937	Nov. 8,
1994		
	(filed Nov. 8,	
1993)		

The claims under appeal stand rejected under 35 U.S.C. § 103 as follows:

(1) Claims 5, 6, 9 to 12 and 14 as being unpatentable over Holcomb in view of Wiese;

(2) Claim 13 as being unpatentable over Holcomb in view of Wiese, as applied to claim 5, and further in view of Lofstedt; and

(3) Claims 1, 4 to 6 and 9 to 19 as being unpatentable over Hendricks in view of Wiese.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 10, mailed July 20, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 9, filed April 30, 1998) for the appellant's arguments thereagainst.

OPINION

Initially we note that the drawing objection set forth in the final rejection (Paper No. 7, mailed November 25, 1997) relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by the appellant on pages 4-8 of the brief.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 4 to 6 and 9 to 19 under 35 U.S.C. § 103. Our reasoning for this determination follows.

Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468,

1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellant's claims 1, 4 to 6 and 9 to 19 to derive an understanding of the scope and content thereof.

Before turning to the proper construction of the claims, it is important to review some basic principles of claim construction. First, and most important, the language of the claim defines the scope of the protected invention. Yale Lock Mfg. Co. v. Greenleaf, 117 U.S. 554, 559 (1886) ("The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification."); Autogiro Co. of Am. v. United States, 384 F.2d 391, 396, 155 USPQ 697, 701 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth [in the claim]."). See also Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 419 (1908); Cimiotti Unhairing Co. v. American Fur Ref. Co., 198 U.S. 399, 410 (1905). Accordingly, "resort must be had in the first instance to the words of the claim" and words "will be given their ordinary

and accustomed meaning, unless it appears that the inventor used them differently." Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984). Second, it is equally "fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966).

Furthermore, the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim must be followed. See In re Priest, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). One must be careful not to confuse impermissible imputing of limitations from the specification into a claim with the proper reference to the specification to determine the meaning of a particular word or phrase recited in a claim. See E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir.), cert. denied, 488 U.S. 986 (1988).

With this as background, we find it necessary to determine the meaning of the phrase "said plurality of mounting holes being formed in an orderly rank and file configuration" as recited in all the claims under appeal.

A review of the disclosure reveals that the appellant did not provide an explicit definition for this phrase. Furthermore, it is apparent that the appellant did not use "rank and file" in its ordinary and accustomed manner. Accordingly, we must determine the implicit definition for this phrase from the disclosure (i.e., the specification and drawings). In this regard, the specification reveals: (1) the appellant was concerned with the X and Y coordinates of the pick point (pp. 3 and 11); (2) the mounting holes 42 are provided in a uniformly spaced rectangular array with preferably eight or nine rows of approximately fifteen mounting holes, however Figure 3 shows an acceptable ten by ten grid of mounting holes (p. 7); (3) the eight or nine rows of mounting holes are spaced about 0.375 inches apart and the fifteen mounting holes in each row are spaced about 0.197 inches apart (p. 9); (4) each guide lane 20 is provided with

two mounting holes 44 which are spaced apart about 0.75 inches so as to align with the mounting holes 42 (p. 10); and (5) the orderly rank and file configuration of the mounting holes facilitates adjustment of the guide lanes (abstract).

From this review of the appellant's disclosure, we have determined that the appropriate meaning for the phrase "said plurality of mounting holes being formed in an orderly rank and file configuration" is that the mounting holes are formed in configuration having at least a three by three grid wherein the spacing between rows is uniform (i.e., constant) and the spacing between the holes in each row is uniform (i.e., constant).²

With this meaning of the phrase "said plurality of mounting holes being formed in an orderly rank and file configuration" having been determined, we now turn to the examiner's rejections under 35 U.S.C. § 103.

² This meaning is consistent with the appellant's argument for patentability set forth on pages 14-18 of the brief concerning the two-dimensional adjustability (i.e., X and Y coordinates) at the pick-up point.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Rejections (1) and (2)

We will not sustain the rejection of claims 5, 6, 9 to 12 and 14 as being unpatentable over Holcomb in view of Wiese. Likewise, we will not sustain the rejection of claim 13 as being unpatentable over Holcomb in view of Wiese, as applied to claim 5, and further in view of Lofstedt.

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art

to make the selection made by the appellant. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellant's invention. As in all determinations under 35 U.S.C. § 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462,

221 USPQ 481, 488 (Fed. Cir. 1984). In determining obviousness/nonobviousness, an invention must be considered "as a whole," 35 U.S.C. § 103, and claims must be considered in their entirety. Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

With this as background, it is our opinion that the appellant (brief, pp. 14-19) is correct that there is no reason/suggestion/motivation for combining Holcomb and Wiese in the manner set forth in these rejections. That is, we see no reason absent the use of impermissible hindsight to have provided Holcomb's deck member 120 with a plurality of mounting holes formed in an orderly rank and file configuration.

Since all the limitations of claims 5, 6 and 9 to 14 would not have been suggested by the applied prior for the reasons stated above, the decision of the examiner to reject claims 5, 6 and 9 to 14 under 35 U.S.C. § 103 is reversed.

Rejection (3)

We will not sustain the rejection of claims 1, 4 to 6 and 9 to 19 as being unpatentable over Hendricks in view of Wiese.

It is our opinion that the appellant (brief, pp. 21-22) is correct that there is no reason/suggestion/motivation for combining Hendricks and Wiese in the manner set forth in this rejection. That is, we see no reason absent the use of impermissible hindsight to have provided Hendricks' deck member 24 with a plurality of mounting holes formed in an orderly rank and file configuration.

Since all the limitations of claims 1, 4 to 6 and 9 to 19 would not have been suggested by the applied prior for the reasons stated above, the decision of the examiner to reject claims 1, 4 to 6 and 9 to 19 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 4 to 6 and 9 to 19 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APJ NASE

APJ McQUADE

APJ ABRAMS

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 01 Jul 99

FINAL TYPED:

Gloria: Change panel order